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Mailed:
January 10, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lawman Holdings Limited

Serial No. 78405703

James M. Lee of Lee & Tran for Lawman Holdings Limited.

Bridgett G. Smith, Trademark Examining Attorney, Law Office
115 (Tomas V. Vlcek, Managing Attorney).

Before Quinn, Bucher and Walsh, Administrative Trademark
Judges.

Opinion by Walsh, Administrative Trademark Judge:

On April 21, 2004, Lawman Holdings Limited (applicant)
filed an intent-to-use application to register PETROJEANS,
in standard character form, on the Principal Register for
goods now identified as, "wearing apparel, namely, jeans,
pants, shorts, skirts, jackets, outerwear, woven shirts, t-
shirts, blouses, dresses, hats, headwear, footwear, belts
for sale through retail channels of trade excluding truck

stops and the marketing, sales and trade channels for truck stops" in International Class 25.¹

The examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the mark in Reg. No. 1615532,² owned by Petro Stopping Centers, L.P., as shown below, for goods in International Class 25 identified as, "work shirts, t-shirts, polo shirts, sweaters, overalls and hats," as well as goods and services in International Classes 9, 12, 14, 16, 21 and 37.



The registration claims both first use anywhere and first use in commerce as to the Class 25 goods in October 1984.

¹ Applicant amended the identification of goods to insert the following trade-channel limitation in response to the examining attorney's first action: ". . . for sale through retail channels of trade excluding truck stops and the marketing, sales and trade channels for truck stops."

² The examining attorney had refused registration also based on Reg. No. 1203914 for PETRO STOPPING CENTER owned by the same registrant. Although the examining attorney explicitly withdrew the refusal as to the second registration in her final refusal, she refers to it in her brief. Because the refusal as to the second registration was withdrawn, we will not address it in this opinion.

The registration also includes the following statement:

"The mark is lined for the colors green and orange." The registration issued on October 2, 1990, and registrant has renewed the registration which is currently active.

Applicant responded to the refusal; the examining attorney made the refusal final; and applicant filed this appeal. For the reasons indicated below, we affirm.

Section 2(d) of the Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion . . ." Id. The opinion in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977) sets forth the factors we may consider in determining likelihood of confusion. Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the goods of the applicant and registrant. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."). Below we will discuss all factors as to which applicant argued or presented evidence.

Comparison of the Goods and Channels of Trade

Applicant argues that its goods differ from those of the registrant. In point of fact, applicant's argument focuses nearly exclusively on the trade channels for the registrant's goods. As applicant states, "Quite simply, there is no way that the same consumer is going to find similar items with PETRO and with PETROJEANS in the same place. Petro Stopping Centers [registrant] puts its mark PETRO on most of the items found at its truck stops, in the same way that a retail store or restaurant may put their name on a shirt and sell it solely in that store. PETROJEANS would not be found in a truck stop (especially since the applicant has excluded truck stops and those channels of trade) any more than a sweat shirt with an orange and green PETRO design would be found in a department store." Applicant extrapolates from the assumptions expressed here and argues at length regarding the alleged distinctions between its marketing and trade channels and registrant's. To support its assumptions it provides a few pages allegedly from the web site of the registrant; the pages provide limited information regarding "Petro Stopping Centers," a chain of highway rest stops.

In comparing the goods, we must consider the goods as identified in the application and registration. CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991). A simple comparison of the goods identified in the application and registration reveals that both include identical items, t-shirts and hats. Applicant's goods also include items, such as, woven shirts, which could include items identified in the registration, such as, work shirts and polo shirts. Furthermore, both the application and the cited registration include a variety of clothing items, and, as the examining attorney notes, the Board has previously found various clothing items to be related. See, e.g., Jockey Intl., Inc. v. Mallory & Church Corp., 25 USPQ2d 1233, 1236 (TTAB 1992); In re Pix of America, Inc., 225 USPQ 691, 692 (TTAB 1985) and cases cited therein. Therefore, there is no question but that the goods of the applicant and registrant, as identified in the application and registration, are, at least in part, identical and otherwise overlapping or related.

Turning to the focus of applicant's argument, the same applies with regard to the channels of trade for the goods. That is, ". . . we must assume, absent any restrictions in the identification of goods of the cited registration, that

the goods move in all of the channels of trade which are normal for such goods." In re Pix of America, Inc., 225 USPQ at 691, citing Paula Payne Products Co. v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76 (CCPA 1973).

Consequently, applicant's restriction of its own trade channels in the identification of goods in the application is futile because the cited registration includes no restrictions as to trade channels. Furthermore, we may not consider extraneous evidence, such as the Internet web pages applicant provided allegedly from registrant's web site, to interpose restrictions to registrant's trade channels not stated in the registration.

Accordingly, we conclude that the goods of applicant and registrant are identical, at least in part, and otherwise related, and that the goods of both applicant and registrant move in the same or overlapping channels of trade.

Furthermore, we note that, "the degree of similarity [between the marks] necessary to support the conclusion of likely confusion declines" when the goods are identical. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), cert. denied, 506 U.S. 1034 (1992).

The Marks

Applicant argues that the marks differ when viewed in their entireties and asserts that the examining attorney failed to view the marks in their entireties, as required. The examining attorney argues principally that "PETRO" is the only distinctive word element, and therefore, the dominant element in the cited mark, and that "PETRO" is the first and only distinctive element, and therefore, the dominant element in applicant's mark. The examining attorney argues further that the marks are similar overall because they share the same dominant element and because the elements which differ are insufficient to distinguish the marks.

To determine whether the marks are confusingly similar, we must consider the appearance, sound, connotation and commercial impression of each mark. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

First, we must establish which marks, or versions of the marks, must be compared. The registered mark is in special form, as shown above. Therefore, the form shown above is the operative version for purposes of our comparison. Applicant's mark is in standard-character

form. Applicant argues, "PETRO, as registered by Petro Stopping Centers, has block letters with orange and green stripping as a background, whereas applicant's mark, PETROJEANS, is a typed word mark with no other distinctive features. These marks side by side do not create the same impression nor do they look like they are from the same source."

Implicit in applicant's argument is an assumption that its mark is limited to the generic "typed" display of the standard-character form. This assumption is incorrect. When a mark is displayed in standard-character form we must consider all reasonable manners in which the word mark could be depicted. See Jockey Intl., Inc. v. Mallory & Church Corp., 25 USPQ2d at 1236 and cases cited therein.

Furthermore, applicant's suggestion that a "side by side" comparison is appropriate is also misplaced. Such a comparison is not consistent with the way marks are encountered in the marketplace. Rather, ". . . the emphasis must be on the average purchaser, who normally retains a general rather than a specific impression of trademarks." Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106, 108 (TTAB 1975) and cases cited therein.

We agree with the examining attorney. That is, we conclude that "PETRO" is the only distinctive word element

in both applicant's mark and the cited registered mark, and therefore, the dominant element in both marks. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). We note further that "PETRO" is the only literal element in the cited registered mark and the first literal element in applicant's mark. Presto Products, Inc. v. Nice-Pak Products Inc., 9 USPQ2d 1895, 1897 (TTAB 1988). In Presto the Board considered the significance of two marks, KIDWIPES and KID STUFF, starting with the same term, ". . . [it is] a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered." Id. Here it is of particular importance because applicant merely adds a generic term to the registered mark. This addition is insufficient to distinguish the marks.

Applicant also implies that the stylized display of the registered mark, including the orange and green "stripping" or rectangular background, distinguishes the marks. This "design" does nothing to either diminish the dominance of "PETRO" in the cited mark or to distinguish the marks overall. In re Dixie Restaurants, Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997).

Applicant stated its core argument regarding the marks as follows, "However, it appears that the [examining]

attorney completely ignored the registered mark and the applicant's mark in their entirety and focused solely on the first part of each mark, 'PETRO.'" As the Court of Appeals for the Federal Circuit observed in National Data, ". . . in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." In re National Data Corp., 224 USPQ at 751. In fact, the examining attorney was careful to point out that she was considering the marks in their entireties.

Accordingly, we have considered the marks overall and conclude that "PETRO" is the dominant word element in the marks. In re Sunmarks Inc., 32 USPQ2d 1470, 1472 (TTAB 1994). We conclude further that the marks are highly similar in appearance, sound, connotation and commercial impression because they share the same dominant word element and lack any significant distinguishing features.

Other Factors

Applicant also presents arguments related to the du Pont factors which address: "The Conditions under which and buyers to whom sales are made," and "The extent of

potential confusion (de minimus (sic) or substantial)."

However, in each instance applicant again assumes certain restrictions with regard to the registrant's goods and its channels of trade. For example, as to the former factor applicant states, ". . . it is highly unlikely that the person will think for one second that the jeans that they are trying on in the mall that say PETRO is (sic) from the same source as the t-shirt they bought at a gas station with the orange and green PETRO." And as to the latter factor, applicant states, "Can clothing sold in department stores possibly threaten the commercial interests of highway truck stops?" There is no justification for assuming restrictions not stated in the registration under these factors for the same reasons we provided above in discussing the goods and the channels of trade. See In re Pix of America, Inc., 225 USPQ at 691. Accordingly, we find these arguments likewise unpersuasive.

Conclusion

After considering all of applicant's arguments and evidence bearing on the du Pont factors, we conclude that there is a likelihood of confusion between applicant's mark and the cited registered mark principally because the goods of applicant and registrant and the channels of trade for those goods, as specified in the application and

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registration, are identical at least in part, and because the marks are highly similar.

Decision: The refusal to register applicant's mark under Section 2(d) of the Act is affirmed.